

REMARKS

Applicant requests reconsideration and allowance in view of the foregoing amendments and the following remarks. Claims 1-19 and 21-31 are pending with claims 1, 16-19, 23, 24 and 31 being independent.

The Examiner has rejected claims 1-25 as obvious over U.S. Patent No. 6,149,669 (Li) in view of U.S. Patent No. 6,066,160 (Colvin).

Applicant requests withdrawal of the rejection at least because one of ordinary skill in the art would have no motivation to modify Li in the manner that the Examiner is suggesting.

Li is directed to a surgical fastener method that eliminates the need for the surgeon to have to thread sutures through a ligament being secured to bone. *See, e.g.* Li at col. 1, lines 13-20. To this end, Li describes providing suture anchors coupled by a fixed length of suture. *See e.g.,* Li at col. 5, lines 7-19. A first anchor with attached suture is passed through the ligament and into a bore hole in the bone. *See, e.g.,* Li at col. 5, lines 38-43 and Fig. 5. A second anchor, which is also attached to the suture, is passed through the ligament and into a second bore hole into the bone. *See, e.g.,* Li at col. 5, lines 56-58 and Fig. 5. When the required tension in the suture is achieved, the anchor is deployed in place in the hole such that the suture spans between the anchors across the ligament with a preset tension to secure the ligament to the bone. *See, e.g.,* Li at col. 5, line 58 to col. 6, line 6 and Figs. 5 and 5A.

As the Examiner concedes, Li does not disclose a means of restricting the flexible member in a direction.

Colvin is directed to a suture securing apparatus having an aperture that permits suture to move in one direction but opposes movement of the suture in the opposite direction. *See, e.g.,* Colvin at col. 8, lines 58-64. One skilled in the art presented with Li and Colvin would have no motivation to use Colvin's aperture in the surgical fastener of Li because the object of Li is to have a fixed length of suture that in use advantageously requires no manipulation of the suture. In the method of Li, the surgeon simply places the anchors with the pre-attached fixed length of suture into bone holes and the suture is held in place with a preset tension to secure the ligament to bone. Modification of Li's surgical fastener in the manner suggested by the Examiner would

Applicant : Graham Smith
Serial No. : 09/986,392
Filed : November 8, 2001
Page : 8 of 8

Attorney's Docket No.: 00167-441001 / 02-31-0354

destroy the advantage of Li's surgical fastener method, i.e., a method that requires no manipulation of the suture.

The Examiner states that the "aperture of Colvin et al. ... [allows] the flexible member to be adjusted in increments without ties or knots that are not suitable in certain tissues" and that Colvin's "means of restriction creates versatility for terminating sutures and securing tissue anchors in place." However, this does not provide motivation to modify Li's surgical fastener in the manner suggested by the Examiner considering that any such modification would destroy the advantage of Li's surgical fastener method.

Because there is no suggestion or motivation for modifying Li as proposed by the Examiner, applicant respectfully submits that the references do not support a *prima facie* case of obviousness under the provisions of 35 U.S.C. §103. Therefore, applicant submits that for at least the reasons discussed above, claims 1-19 and 21-25 are allowable over Li in view Colvin.